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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,328	03/16/2001	Long Yu	9548.50USWO	9496
23552	7590	02/06/2004	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			HAYES, ROBERT CLINTON	
			ART UNIT	PAPER NUMBER
			1647	
DATE MAILED: 02/06/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/787,328	<b>Applicant(s)</b> YU ET AL.	
	<b>Examiner</b> Robert C. Hayes, Ph.D.	<b>Art Unit</b> 1647	

**– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –**

**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 6-15 is/are pending in the application.
- 4a) Of the above claim(s) 12-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-3 and 6-15 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/18/01</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restriction*

1. Applicant's election with traverse of Group I (claims 1-3 & 6-11) in Paper No. 10/20/03 is acknowledged. The traversal is on the ground(s) that "the present application is a national-stage application filed under 35 U.S.C. 371", and "[a]ccordingly, the unity of invention practice, and not restriction practice, is applicable... [in which] the applicant has the right to include in a single application all inventions linked so as to form a single general inventive concept... [as it relates to possessing a] '[s]pecial technical feature' ". This is not found persuasive because no *special* technical feature exists for Group I as defined by PCT Rule 13.2, because the International Search Report cited X-reference Nakamura et al (1994), who teach molecules that can hybridize, etc. to nucleotides 121-732 in SEQ ID NO: 3, as originally submitted; thereby, not defining a contribution over the prior art. Note that PCT Rule 13 does not provide for multiple products or methods within a single application. See MPEP 1893.03. Thus, because the technical feature of Group I is not a "special" technical feature, and because the technical features of the Group II-IV inventions are not present in the Group I claims, unity of invention is lacking, and therefore, would further constitute an undue search burden on the Examiner for searching and examining this art recognized distinct subject matter. Thus, the requirement is still deemed proper, as it relates to a lack of unity for the four previously (restricted) groups, and is therefore made FINAL.

Claims 12-15 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in Paper No. 10/20/03.

This application contains claims 12-15 are drawn to an invention nonelected with traverse in Paper No. 10/20/03. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

***Claim Rejections - 35 U.S.C. § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 7 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. For example, the current recitation of "A host cell" encompasses a human organism, for example, after gene therapy. Therefore, it is suggested that amending the claims to "an isolated host cell" should obviate the rejection of claim 7.

***Claim Rejections - 35 U.S.C. § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Priority of the instant application is held to be 6/09/99, because foreign priority to Chinese patent 98119758.2 (filed 9/22/99) has not been perfected in accordance with 37 CFR 1.55. In other words, no translation of said paper has been made of record.

Art Unit: 1647

Claims 1-3 & 9-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Benson et al. (U.S. patent 6,468,758; priority of 9/23/98).

Benson et al. teach a human DNA molecule (SEQ ID NO: 68) that "comprises" 121-732 of SEQ ID NO: 3, and therefore, inherently encodes the polypeptide consisting of SEQ ID NO: 4 (e.g., Fig. 16I, cols. 4, 8 & 11-12; as it relates to claims 1-3). In that Benson et al teach inserting their DNA sequence into expression vectors and transfection of *E. coli* and eukaryotic host cells (cols. 11-12), the limitations of claims 6-9 are met. In that methods of producing polypeptides from Benson's DNA molecules are disclosed in columns 11-12, the limitations of claims 10 & 11 are anticipated.

### ***Conclusion***

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Robert Hayes whose telephone number is (571) 272-0885. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached on (571) 272-0887. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Robert C. Hayes, Ph.D.  
February 4, 2004

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